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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,678	01/11/2002	Harold L. Schafer	Techpro # 1-2	7412
7590 10/03/2003			EXAMINER	
ARTHUR R. EGLINGTON, ESQ. 113 Cross Creek Drive RD # 5 Pottsville, PA 17901			COOLEY, CHARLES E	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,678	SCHAFFER ET AL.	
	Examiner	Art Unit	
	Charles E. Cooley	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Election of Species

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species A: Figures 4-8 and Species B: Figures 9-13.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Arthur Eglington on 16 SEP 2003 a provisional election was made with traverse to prosecute the invention of Species B, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claim 8 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

4. Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "74" – see page 7, line 8. A proposed drawing correction or corrected

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drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The disclosure is objected to because of the following informalities:

- a. Page 1, line 4: the status of the parent application should be updated as being U.S. Patent No. 6,390,666.
- b. Page 4, lines 7, 14, and 17: the extraneous legends (such as "MA061") should be deleted.
- c. Page 6, line 20: replace "52R" with - -52L - - to agree with Fig. 3.
- d. Page 6, line 21 contains an extraneous period after "collar-like".
- e. Page 8, line 13: "sleeve" should be replaced with - -metal liner--.

Terminology attributed to an elements must be kept consistent throughout the specification.

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- f. Page 8, line 15: replace "bushing" with --sleeve assembly--. Terminology attributed to an elements must be kept consistent throughout the specification.
- g. Page 9, line 17: replace "104B" with --104--.
- h. Page 9, line 20: replace "house" with --housing--.

Appropriate correction is required.

- 8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title should mention the air supply to the seal.
- 9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter of claim 3 lacks antecedent basis in the specification.

Claim Rejections - 35 USC § 112

- 10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 11. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims lack proper structural cooperation between the recited elements. The structure which goes to make up the device must be clearly and positively specified.

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The structure must be organized and correlated in such a manner as to present a complete operative device.

The preambles of the claims are not consistent with each other leading to confusion.

Terms such as "the companion seal retainer" (claim 5); "the mated seal house" (claim 6) and "the seal house member" (claim 7) lack antecedent basis. All claim terms must have proper antecedent basis.

Claim 1, last line contains an extraneous period.

Claim 6: the relationship or distinction between the elements of claim 6 and the elements (a), (b), and (c) of claim 1 is unclear.

Claim 7, line 1 contains the misspelled word "radiacly".

Claim 3 contains the trademark/trade name "VITON". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any

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particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a seal material and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1 and 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art of claim 1 in view of Johnston (US 4,270,762).

Claim 1 is considered to be in the format specified by 37 CFR 1.75(e) which reads as follows:

37 CFR 1.75

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

- (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,
- (2) A phrase such as "wherein the improvement comprises," and
- (3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

Accordingly, the language in claim 1 appearing prior to "the improvement being in the oil seal retainer component which comprises" is deemed "conventional or known"

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pursuant to 37 CFR 1.75(e) and therefore admitted prior art. The admitted prior art does not disclose the elements (a), (b), or (c) of claim 1 or the subject matter of claims 2 and 4-7. The patent to Johnston (US 4,270,762) discloses a sealing arrangement for a driven shaft 21 disposed in a housing 22. The shaft 21 has a sleeve 44 thereon. Packing rings 40-43 and 62-65 of square cross section are disposed in a seal housing 37 and abut inner surfaces of a seal retainer assembly 46, 56, and 57. An annular channel 82 is disposed substantially centrally of the seal retainer assembly and communicates with a radially disposed fluid conduit 81 which is connected to a means 31 for supplying a gas to the fluid conduit 81. The seal retainer assembly has truncated segments (proximate 66 and 83). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the admitted prior art arrangement with a sealing arrangement as disclosed by Johnston for the purposes of cleaning the shaft, to render the seal assembly not susceptible to destruction, to prevent distortion of the shaft, and to prevent migration of the material being processed in the housing through the seal assembly to reduce wear of the sealing assembly and shaft (col. 1, lines 61-68; col. 2, lines 39-48; col. 3, lines 3-29; and col. 7, lines 49-62).

14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art of claim 1 in view of Johnston (US 4,270,762) as applied to claim 1 above, and further in view of Sytsma (US 4,863,293).

15. Applicant's admitted prior art of claim 1 in view of Johnston (US 4,270,762) does not disclose the recited material of the seal set forth in claim 3. The patent to Sytsma

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(US 4,863,293) discloses a seal made of the material recited in claim 3 such as VITON. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have formed the seal components in Applicant's admitted prior art of claim 1 in view of Johnston (US 4,270,762) from a material such as VITON to provide a seal which has the desirable characteristics of flexibility, memory, resiliency, high temperature resistance, toughness, tear, and chemical resistance (col. 3, lines 30-36).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited prior was cited in the parent application and additionally shows pressurized sealing assemblies.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley whose telephone number is (703) 308-0112. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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A handwritten signature in cursive script, appearing to read "Charles", followed by a stylized flourish.

Charles E. Cooley
Primary Examiner
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22 September 2003